

## REMARKS

Claims 2-9, 41, 43-54, 68, 69, 78 and 79 are pending in this matter. Claims 43 and 69 are independent claims.

By final Office Action mailed September 4, 2008, the Examiner rejected all pending claims under Section 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. The Examiner also rejected all pending claims under Section 102 as being anticipated by Carlisle et al. (US 5,649,118 A).

Applicants have amended claim 43 to overcome the rejection under Section 112 of claim 43 and of the claims that depend from claim 43. Applicants have also amended claim 43 to correct a typographical error, inserting the word "card" to form the phrase "operably connected to an integrated circuit card".

Applicants respectfully argue that the rejection of claim 69 under Section 102 and the rejection of all pending claims under Section 102 are in error.

### **I. Claim Rejections – 35 USC § 112**

The Examiner rejected all pending claims under Section 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. First, the Examiner asserts that claim 43 is indefinite because it is unclear whether "a host device" on line 15 of this claim refers to "a host device" recited at line 12 of this claim.

To overcome this objection, Applicants have amended claim 43 so that it now recites in part "... a standalone mode in which the interface device is not operably connected to any host device". With this change, it is clear that the phrase "any host device" does not recite an element of the claimed device but that it is instead a part of the phrase "not operably connected to any host device" used in claim 43 to describe the interface device in a standalone mode of operation.

The Examiner further rejected dependent claims 2-9, 41, 44-54, 68, 78 and 79 for fully incorporating the deficiencies of their base claim. Claim 43 being in condition for allowance, these claims should also be in condition for allowance, because they depend from claim 43 and for the further limitations they contain.

Examiner did not detail the reason for rejecting independent claim 69 under Section 112, and Applicants maintain that this claim is not indefinite and is in condition for allowance.

## **II. Claim Rejections – 35 USC § 102**

The Examiner also rejected all pending claims under Section 102 as being anticipated by Carlisle et al. (US 5,649,118 A).

### Claim 69

The Examiner asserts that Carlisle ('118) teaches all of the limitations of claim 69, referring to column 17, line 20 – column 18, line 56, in the '118 patent. This section of the '118 patent teaches a portable smart card, interfaced to a point-of-sale terminal. As the Examiner observes, the card is portable, contains memory, runs an executable operating system, and contains a file system. The claims in the instant application, however, are directed not to a smart card or integrated circuit card, but to an integrated circuit card **interface device**.

In the section of the '118 patent referenced by the Examiner, both the point-of-sale terminal **418**, and the smart card reader/writer **415** it contains, interface to a smart card, but neither of these devices embodies the limitations of claim 69.

The referenced section of the '118 patent makes no mention of the point-of-sale terminal **418** being portable, having a host interface, means for operating without external power, or means for a reprogramming mode of operation. Indeed, the '118 patent teaches away from an integrated circuit card interface device that is portable. The '118 patent is directed towards a smart card and an interface to the

smart card that is a point-of-sale terminal or an interface subsystem within the point-of-sale terminal. In the system disclosed in the '118 patent, a consumer selects a plurality of items to be purchased and brings them to the point-of-sale terminal (column 3, lines 40-44). This suggests that the point-of-sale terminal is stationary; otherwise it would be difficult for consumers to locate it.

As to the smart card reader/writer **415**, the referenced section of the '118 patent makes no mention of this smart card reader/writer being portable, having an input/output module, or means for operation without external power. As with the point-of-sale terminal **418**, the '118 patent teaches away from the smart card reader/writer **415** being portable, the latter being a component of the former. Moreover, the host to the smart card reader/writer **415**, if it can be said to have one, is the remainder of the point-of-sale terminal **418**, and the referenced section of the '118 patent does not disclose that the smart card reader/writer has a standalone mode of operation in which the smart card reader/writer is not connected to the host. Finally, the referenced section of the '118 patent does not disclose that the smart card reader/writer **415** has means for a reprogramming mode of operation.

Carlisle et al. does not teach or fairly suggest, alone or in combination with any other reference, a portable integrated circuit card interface device, comprising: an application memory; an application engine for managing one or more applications in said application memory; an input/output module; a host interface; one or more integrated circuit card interfaces; means for operation without external power; means for a standalone mode of operation in which the interface device is not operably connected to a host device via the host interface, and means for a reprogramming mode of operation for adding, modifying, or deleting programs from the interface device.

Claim 69 is therefore believed to be in condition for allowance.

Claim 43

The Examiner asserts that Carlisle ('118) teaches all of the limitations of claim 43, referring to column 17, line 20 – column 18, line 56, in the '118 patent. For reasons analogous to those given for claim 69, Applicants respectfully argue that the '118 patent does not anticipate claim 43.

Again, in the referenced section of the '118 patent both the point-of-sale terminal **418**, and the smart card reader/writer **415** it contains, interface to a smart card, but neither of these devices embodies the limitations of claim 43.

The referenced section of the '118 patent does not teach a host interface for the point-of-sale terminal **418**, nor a reprogramming mode of operation.

The referenced section of the '118 patent does not teach an input/output module for the smart card reader/writer **415**, nor a reprogramming mode of operation. Moreover, the host to the smart card reader/writer **415**, if it can be said to have one, is the remainder of the point-of-sale terminal **418**, and the referenced section of the '118 patent does not teach a standalone method of operation in which the smart card reader/writer **415** is not operably connected to the point-of-sale terminal **418**.

Carlisle et al. does not teach or fairly suggest, alone or in combination with any other reference, an integrated circuit card interface device comprising: an application memory; an application engine for managing one or more applications in said application memory; an input/output module; a host interface; one or more integrated circuit card interfaces; and an internal power supply; wherein the interface device is adapted to enable operation in accordance with multiple modes of operation comprising a standalone mode of operation in which the interface device is not operably connected to any host device via the host interface, and a reprogramming mode of operation, in which the interface device is operably connected to an integrated circuit card via one of the one or more integrated circuit card interfaces, and/or to a host device via the host interface, to enable one or more programs to be added to, modified in, or deleted from, the interface device.

Claim 43 is therefore believed to be in condition for allowance.

Dependent claims 2-9, 41, 44-54, 68, 78 and 79

Claim 43 being in condition for allowance, dependent claims 2-9, 41, 44-54, 68, 78 and 79 are also believed to be in condition for allowance, because they depend from claim 43. Several of these claims also are believed to be in condition for allowance for the additional limitations they contain. In particular:

*Claim 3:* The referenced section of the '118 patent does not teach a smart card reader/writer **415** nor a point-of-sale terminal **418** containing an electrically erasable programmable read-only memory.

*Claims 7, 8, and 9:* The referenced section of the '118 patent makes no mention of a custom circuit.

*Claim 41:* The referenced section of the '118 patent describes a portable **smart card**, but does not teach a portable integrated circuit card **interface device**.

*Claim 78:* The referenced section of the '118 patent does not teach a reprogramming mode of operation of either the reader/writer **415** or the point-of-sale terminal **418**, and thus does not mention programs added to, modified in, or deleted from the interface device in such a mode of operation being subject to security verification.

*Claim 79:* The referenced section of the '118 patent does not teach a smart card reader/writer **415** nor a point-of-sale terminal **418** being operable while being carried by a user.

**III. Patent 6,769,620 to Devaux et al.**

Applicants have recently become aware of, and are disclosing in an Information Disclosure Statement, U.S. Patent Application Publication No. 2001/0045453 A1, and the corresponding U.S. patent, No. 6,769,620, by Devaux et

al.. This patent has a §371(c)(1), (2), (4) date of February 1, 1999. To avoid delays in prosecution that would result from an office action citing this application or patent, Applicants submit herewith the declaration of Paul Chau, with accompanying exhibits, to prove conception and actual reduction to practice prior to February 1, 1999.

### **REQUEST FOR INTERVIEW**

Applicants request that if Examiner has any questions regarding the Rule 131 Declaration, or exhibits, that Examiner phone the undersigned.

### **CONCLUSION**

Applicants believe that all pending claims are allowable and a Notice of Allowance is respectfully requested.

A three month extension is believed due. The Commissioner is authorized to charge the extension fee, and any additional fee that is due to Deposit Account No. 19-2090.

Respectfully submitted,  
SHELDON MAK ROSE & ANDERSON PC

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